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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,924	02/25/2004	Ben-Zion Dolitzky	1662/568078	9231

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EXAMINER	
CHANG, CELIA C	

ART UNIT	PAPER NUMBER
1625	

MAIL DATE	DELIVERY MODE
03/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/788,924	DOLITZKY ET AL.	
	Examiner	Art Unit	
	Celia Chang	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 10-16* is/are pending in the application.

4a) Of the above claim(s) *4-6 and 10-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Response filed by applicants dated Jan. 12, 2009 have been entered and considered carefully.

Claims 1-3 and 14-16 reading on 1-3 are pending. Claims 7-9 have been canceled. Claims 4-6, 10-13 stayed withdrawn.

2. The rejection of claims 1-3 under 35 USC 112 second paragraph is maintained for reason of record.

Applicants argued that the meets and bounds is clear in the claims therefore no indefiniteness was observed. This is not persuasive. Please note that it was clearly explained in the previous office action that X-ray powder diffraction alone does not determine the product being claimed. Two products having different chemical identities can exhibit identical X-ray pattern (Berstein provided). It was further explained that the X-ray peaks of claims 1 and 2 are described in the specification to be corresponding to MTBE or cyclohexane solvate therefore the inconsistency is apparent. It was also explained that one skilled in the chemical art in this century would not have any difficulty in finding the chemical identity thus demarcate a solvate from a nonsolvated compound. Applicants must determine what is the product being claimed and employ proper identity for the product consistent with the support of the specification.

3. The rejection of claims1-2 under 35 USC 102(b) over Ortyl '872 is maintained for reason of record.

As it was delineated that powder X-ray diffraction can have tremendous artifacts during measurement. Unlike single crystal X-ray diffraction pattern, all the peaks can be suppressed except one for the same crystal from its single crystal data (see Bersten p.118 provided previously). Therefore, to the extend the claims are "fexofenadine hydrochloride" having the lines of powdered diffraction pattern, if one peak is matching, anticipation is found because there is no description as to how the *powdered* data was obtained and how many peaks are artifacts and which ones must or must not be there to identify the form. Were the product having a *different* chemical identity, then, even if powdered X-ray diffraction pattern are identical, they

are isomorphism of different products. Please note that claim 1 is drawn to "fexofenadine hydrochloride". While fexofinadine hydrochloride having the powdered lines anticipates the claims, fexofenadine hydrochloride cyclohexane solvate having the same lines does not. The specification failed to provide the corresponding powdered X-ray lines of claim 1 or claim 3 corresponding to fexofenadine hydrochloride since they are collected for form IX which is MTBE or cyclohexane solvates of fexofenadine hydrochloride. Therefore, were the claims are intended for "fexofenadine hydrochloride" as the claims, the rejection is proper. Were the claims are intended for form IX, MTBE or cyclohexane solvate of fexofenadine, the 2nd paragraph rejection supra is proper.

3. The rejection of claims 1-3, 14-16 under 35 USC 103(a) over Ortyl in view of Evans and US Pharmacopia and Brittain supplemented with Gottlieb is maintained for reason of record.

Applicants provided self conflicting arguments. Please note that, is claim 1 fexofanidine HCl. MTBE/cyclohexane solvate or is claim 1 "fexofenadine HCl"? Applicants insisted that the claims are solvates (see p.5 response), but failed to demarcate the claims as solvate. Again, it was clearly delineated in the previous office action, small differences between solvent containing crystal and non-solvent containing crystal in a clathrate is considered prima facie. Applicants provided no factual evidence that why the claims are the same or different product. Mere arguments on "powdered" lines , which have been well delineated with state of the art references, such lines are known to be unreliable due to artifacts (no experimental conditions, type of instrument were provided). The nature of clathrate was well known, and many solvents can form clathrates. Just because applicants *felt* that there are too many ordinary laboratory solvents does not offer any unobviousness that MTBE or cyclohexane provided any unexpected results. As a matter of fact, the Evans reference clearly taught one skilled in the art that choosing clathrate depends on "size" of the hole (see p.396), therefore, one having ordinary skill would be clearly guided by the crystalline data as to pick and choose those that will fit into the size constrain for such clathrates.

4. The rejection of claims 14-15 (which should also include 14 and correction is hereby made) under 35 USC 112 first paragraph is maintained for reason of record.

The previous office action provided per ponderous of evidence of the state of the art in preparation of pharmaceutical compositions comprising polymorphic forms and evidenced that tableting and processing procedure *absent of specific handling or material*, would normally result in not maintaining polymorphic form since such meta-stable forms would be transformed into its thermodynamically most stable form. No thermodynamic data was provided to support applicants' allegation that no transformation has occurred. Therefore, contrary to applicants' allegation, guided by knowledge for one having ordinary skill, per ponderous of evidence support transformation then no transformation. Obviate such per ponderous of evidence, factual evidence must be provided for the specific carrier and polymorphic form.

5. The rejection of claim 16 under 35 USC 102(b) over US 4,254,129 is maintained for reason of record.

Again, applicants presented conflicting arguments. The gist of applicants argument is that the compounds administered are MTBE or cyclohexane solvates of fexofenadine hydrochloride thus are not identical to fexofenadine hydrochloride. Again, applicants need to determine "what" is the base intended to be. Is it fexofenadine HCl or is it fexofenadine HCl.MTBE/cyclohexan solvate?

Also, it was clearly taught in section 3 that clathrates are physical entrapment of impurity, therefore, were the MTBE/cyclohexane clathrates, then, the administration is the fexofenadine hydrochloride compound in admixed with some impurity. Therefore, anticipation is still relevant because the therapy was by administering a dose comprising the compound in the prior art method, which allows impurity inherently in the compound by the term comprising.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Mar. 19, 2009

/Celia Chang/
Primary Examiner
Art Unit 1625